

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Kyu Dong KIM, *et al.*

Application No.: 09/725,933

Confirmation No.: 2877

Filed: November 30, 2000

Docket No.: 0766.0002.US

Group Art Unit: 3623

Examiner: DESHPANDE, Kalyan K.

For: **SYSTEM AND METHOD FOR AUTOMATING A PROCESS OF BUSINESS DECISION
AND WORKFLOW**

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Commissioner for Patents

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action mailed June 27, 2006 (Paper No. 20060612) ("Office Action") and the Advisory Action mailed September 27, 2006 (Paper No. 20060916) ("Advisory Action"), Applicants respectfully request review of the above referenced application prior to the filing of an appeal brief because the rejections are clearly not proper and are without basis.

REMARKS

Rejections Under 35 U.S.C. §102

I. The rejection of claims 1-13, 19-20, 24, 26, and 28-31 clearly can not be supported because U.S. Patent No. 6,430,538 issued to Bacon, *et. al.* ("Bacon") does not teach or suggest each and every claimed feature, and "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 is allowable over Bacon. Specifically, claim 1 recites a workflow management system for automating a business process including an administrator executable by the computer where the administrator manages automating the business process and comprises an organization manager, a role/group manager, an authority manager, a process manager, and a folder manager. Hence, the administrator, which is a software module executable by the computer, comprises (1) an organization manager, (2) a role/group manager, (3) an authority manager, (4) a process manager, and (5) a folder manager.

Applicants respectfully submit that the Examiner has made a clear error in rejecting claim 1 in view of Bacon. Specifically, the Examiner relies upon the teaching in Bacon at col. 5, lines 13-14, which states "an administration interface enables a supervisor to manage the system", to teach the administrator disclosed in claim 1 (See Office Action mailed June 27, 2006 on pages 3 and 7). As noted in Applicants' response filed September 7, 2006, Bacon discloses the aforementioned administration interface 140; however, Bacon fails to teach or suggest the administration interface 140 is computer executable or comprises (1) an organization manager, (2) a role/group manager, (3) an authority manager, (4) a process manager, and (5) a folder manager (See pages 12-13). In other words, what the Examiner alleges as the administrator is not computer executable. Neither does it comprise all the elements recited in claim 1, such as the organization manager, role/group manager, authority manager, process manager, and folder manager.

Claim 1 further recites a form generator executable by the computer where the form generator designs and operates an electronic form related to the business process, and where the form generator interfaces with the database, the process designer, the process engine, the web client, and/or the business application program. Hence, the form generator, which is executable by the computer, designs and operates an electronic form related to the business process.

The Examiner asserts that "the java applet is a form generator" (See Office Action mailed June 27, 2006 on page 9). The Examiner also asserts that "the java applet allows for the user of graphic objects, data input cells, and access to the database". (*Id.*) Rather, as noted in Applicants' response filed September 7, 2006, Bacon discloses a java applet that is included in a HTML page and when a predefined java applet is executed by the server in response to a user selection, the java applet distributes that selected work item to a client (See col. 7, line 10 to col. 8, line 40). Thus, Bacon fails to teach or suggest that the java applet designs and operates an electronic form related to the business process. Applicants respectfully note that the Advisory Action does not address these arguments.

Consequently, claim 1 is allowable over Bacon because Bacon fails to teach or suggest the administrator and the form generator as disclosed in claim 1. Claims 2-13, 19-20, 24, 26, and 28-31 depend from an allowable base claim and are in condition for allowance for at least this reason.

Rejections Under 35 U.S.C. §103

II. Claims 14, 16-17, 25, and 27 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable as obvious in view of Bacon. As noted above, Bacon fails to teach or suggest each and every claimed feature as disclosed in claim 1. Claims 14, 16-17, 25, and 27 depend from claim 1 and are allowable at least for the same reasons that claim 1 is allowable.

III. The rejection of claims 32-43 clearly can not be supported because the Examiner has failed to establish a prima facie case of obviousness in view of Bacon. The Examiner fails to establish some suggestion or motivation to modify the reference or to combine reference teachings, fails to establish a reasonable expectation of success, and fails to establish the reference or references, when combined, disclose or suggest all of the claim limitations. The

motivation to modify the prior art and the reasonable expectation of success must both be found in the prior art and not based upon a patent applicant's disclosure. *See in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 32 is allowable over Bacon. Specifically, claim 32 recites a method for automating a business process including the step of modeling the business process where the step of modeling includes generating an organization chart. Hence, the method disclosed in claim 32 requires a step of modeling the business process and further requires generating an organization chart. The method also includes the step of executing the business process where the step of executing the business process includes allocating the activity to a participant, and designing and creating an electronic form related to the business process.

Applicants respectfully submit that the Examiner has made a clear error in rejecting claim 32 in view of Bacon. Specifically, the Examiner fails to show in Bacon the step of modeling the business process. Rather, as noted in Applicants' response filed September 7, 2006, Bacon simply discloses process definitions, which are well known defined concepts to one of ordinary skill in the art familiar with the Workflow Management Coalition Reference Model (<http://www.wfmc.org/standards/model.htm>) upon which Bacon is derived. On the other hand, the modeling process of the present invention is patentably distinguishable from the WPMC Reference Model and the process and system of Bacon. Further, the Examiner simply alleges that an organization chart is obvious, failing to suggest some motivation or suggestion why one of ordinary skill in the art at the time the invention was made would have combined the teachings of Bacon with the teachings of Brodersen and Rosenthal to disclose the claimed features of claim 32. Hence, Applicants respectfully submit that the Examiner fails to show in Bacon or provide a secondary reference disclosing the claimed limitation for the step of modeling the business process as disclosed in claim 32.

Further, Bacon fails to teach or suggest the step of executing the business process as disclosed in claim 32. As noted with respect to claim 1, Bacon fails to disclose designing and creating an electronic form related to the business process. Accordingly, Bacon fails to teach or suggest each and every claimed feature of the present invention as disclosed in claim 32. Applicants respectfully note that the Advisory Action does not address these arguments.

Consequently, claim 32 is allowable over Bacon because the Examiner fails to establish a prima face case of obviousness for the claimed features disclosed in claim 32. Claims 33-43 depend from an allowable base claim and are in condition for allowance for at least this reason.

CONCLUSION

Applicants believe that a full and complete Pre-Appeal Brief Request for Review has been made and respectfully submit that all of the stated grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance. Prompt and favorable consideration of this Pre-Appeal Request for Review is respectfully requested.

Respectfully submitted,

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